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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Valley Oak Law
5655 Silver Creek Valley Road
#106
San Jose, CA 95138

EXAMINER

MENGISTU, AMARE

ART UNIT PAPER NUMBER

2673

DATE MAILED: 09/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,504

Applicant(s)

TREE, JOHN

Examiner

Amare Mengistu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-32 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1,21,27 and 33 of copending Application No. 09/827,472.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of claim 1 "*a display unit including a plurality of display panels positioned on said display unit*" is not clear. How is it possible for a display panels to be

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positioned on a display? How can one position a display panels on a display? It is not clear as to how display panels can be positioned on a display.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "musical file includes a ***text and an image information***" [claim 11] "***spring loaded button***" [claim 12]; "***a television broadcast mark button***" [claim 13]; "***infra red (IR) port***" [claim 15]; "***an external device includes a personal computer, a personal digital assistant, a television, a mobile telephone, a pager; a wireless communication device***" [claim 16]; "received data includes one or more of ***text data, still image data, animated image data and video data*** " [claim 31] must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 20 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Allport (6,104,334).

As to claim 20, 26, Allport teaches detecting a connection to a gateway device (col.8, lines 30-57, col.22, lines 10-65), transmitting stored data marks to said gateway device (col.5, lines 50- col.6, lines 22), receiving said data corresponding to said data marks and displaying said received data (col.6, lines 14-40).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3-9 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cortesi** (6,199,125 B1).

As to claims 1,3-9 and 32, **Cortesi** clearly teaches an electronic data marker device comprising: a display unit (fig.1 (14)) including a plurality of display icons positioned on said display unit (figs.2 and 3 (34)), an input unit for inputting data marks (fig.3 (52)), said display unit is configured to receive said data marks from said input unit and correspondingly display said data marks on said plurality of display panels (col.4, lines 18-36), receiving a data mark; and displaying the data mark (col.4, last lines - col.5, lines 14). **Cortesi** did not explicitly disclose that the plurality of display panels

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positioned on a display. However, it would have been obvious to one skill in the art to recognize that the **Cortesi's** icons can be broadly interpreted as a plurality of display panels as best understood.

As to claims 3-9, **Cortesi's** discloses a display (fig.1 (14)) including a non-overlapping square-shaped icons are arranged uniformly with the same dimensions (fig.3 (34)). It is obvious that the display will have a base mounted on the display device in order to view the information on the display. Also the received data corresponds one or more of said icons (fig.3 (34a, 34b)); illuminating received data marks on a display panels (see, fig.3 (34a) being illuminated when selected).

9. Claims 2,10-19,21-25,27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cortesi** (6,199,125) in view of **Allport** (6,104,334)

As to claims 2,10-19,21-25,27-31, **Cortesi** discloses receiving data marks but has failed to teach a display is a LCD, said data marks includes music file. a LCD (fig.18 (665)) and the data marks include music file information having a text and image (fig.1 (25); fig.3 (130); [text and image fig.8, fig.9]); input unit includes a music broadcast mark and a television broadcast button (col.9, lines 21-24; fig.3 (130), (135)); output unit includes IR port/USB (col.4, lines 21-27, col.22, lines 10-20); an external device includes personal computer (col.8, lines 30-45); the data mark corresponding to music file displayed on external device (col.8, lines 30-57, fig.8). **Cortesi** or **Allport** do not teach that the input unit includes a spring-loaded button. However, it would have been obvious

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to one of ordinary skill in the art to recognize that the input unit of Cortesi's and Allport's provide the same function as the spring-loaded button.

Therefore it would have been obvious to one skill in the art at the time of the invention was made to have be motivated to combine the a music data marks as taught by Allport in to the device of Cortesi, because this will allow the user to download and bookmark musical file for the future reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (703) 305-4880. The examiner can normally be reached on M-F, T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.


Amare Mengistu
Primary Examiner
Art Unit 2673

A.M
September 4,2003